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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/564,134 05/28/96 KREISCHER

T 40-11313

IM11/0904

ROBBINS BERLINER AND CARSON
201 N FIGUEROA STREET
5TH FLOOR
LOS ANGELES CA 90012

EXAMINER

TESKIN, F

ART UNIT

PAPER NUMBER

1713

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DATE MAILED:

09/04/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/564,143

Applicant(s)

Kreischer, et al.

Examiner

Fred Teskin

Group Art Unit

1713



☒ Responsive to communication(s) filed on Jun 8, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-14 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-14 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. The response of June 8, 1998 has been fully considered with the following effect:

(I) the objections and § 112 rejections of the prior action have been obviated by applicant's amendment to the Abstract and to claims 1, 4, 7 and 10;

(II) claims 7-14 are newly rejected under 35 USC § 112, second paragraph, as detailed below;

(III) claim 12 is rejected under 35 USC § 101 as detailed below;

(IV) the rejection of claims 1-6 based on EP '774, alone or in view of EP '364 has been obviated by the amendment to claim 1;

(V) arguments traversing the rejection of claims 1-6 based on EP '145 are deemed moot in view of the new ground of rejection of said claims as presented below;

(VI) claims 7-11, 13 and 14 would be allowable if rewritten to overcome the rejection(s) under 35 USC § 112 set forth in this Office action and to include all the limitations of the base claim and any intervening claims.

2. Claims 7-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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(A) Claim 7 [and claims dependent thereon] is confusing and of improper form in that the claim depends alternatively on itself (note the final line of claim 7). Correction is required.

(B) Claim 11 recites the broad limitation "at least one tear tab," the narrow limitation "two tear tabs" and the linking term "preferably". A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. In the present instance, claim 11 recites the broad recitation "at least one tear tab" and the claim also recites "two tear tabs," which is the narrower statement of the range/limitation.

(C) Claim 12 provides for the "use" of a multichamber medical bag according to claim 7 for preparation of mixed solutions, but, since the claim does not set forth any steps involved in the

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method/process, it is unclear what method/process applicants are intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

3. Claim 12 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-6 are rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Genske et al.

The patent to Genske et al exemplifies multilayer polymer film having two or more layers and wherein at least one layer is formed from a polymeric blend of a polyethylene or polypropylene (co)polymer and an elastomer such as SIS copolymer or SEBS copolymer, the elastomer being present in an amount within the range of claim 5. (See Table 1 in columns 10-11, particularly Example Nos. 2, 4, 10, 13, 18, 20-22, 28, 30, 33 and 35-37.) In the presently claimed film, the phase polymer, which may be a SIS or SEBS block copolymer, is blended with a matrix polymer which is a polyethylene or polypropylene homo- or co-polymer. According to applicants' specification (page 2, lines 25-31), it is the layer of matrix/phase polymer material that enables the obtention of both inseparable seams and subsequently separable seams, i.e., both permanent and peelable bonds. As Genske et al employ species of

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the same matrix and phase polymers in their film constructions, such film is reasonably presumed, absent evidence to the contrary, to intrinsically possess bonding characteristics indistinguishable from those of applicants' film as claimed.

7. Applicants' arguments filed June 8, 1998, to the extent not rendered moot by the new ground of rejection, are unpersuasive for the following reasons.

As to the argument directed to obtaining peelable seals using different welding temperatures, it is noted that claim 1 is drawn to a film which, at a first sealing temperature, forms a peelable bond and, at a second higher sealing temperature, forms a permanent bond; however, examiner does not construe the recitations as to strength of bonds formed at the two temperatures as requiring the film be subjected to such sealing conditions, only that the film material be capable of forming a peelable bond and a permanent bond when sealed at the first temperature and the second higher temperature. As noted above, applicants' specification indicates that because of the matrix/phase polymer material, it is possible to form both inseparable seams and subsequently separable seams. The film of Genske et al includes at least one layer formed from the same kind of matrix and phase polymers as applicants' film, and

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therefore is reasonably presumed to possess the same or similar bonding characteristics.

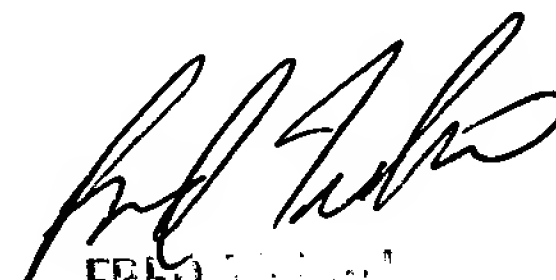
8. This action is non-final.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (703) 308-2456.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Jeffrey Smith, can be reached on (703) 308-4345. The fax phone numbers for this group are (703) 305-5408 and (703) 305-5433.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

FMT/08-25-98


FRED TESKIN
PATENT EXAMINER
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